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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,991	09/24/2003	William J. Kyte	H1938-00036	9732
41396	7590	12/28/2004	EXAMINER	
DUANE MORRIS LLP P. O. BOX 1003 305 NORTH FRONT STREET, 5TH FLOOR HARRISBURG, PA 17108-1003			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,991

Applicant(s)

KYTE ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/1/03, 3/31/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Air-dryable polymeric resins do not exist. Neither do acrylic latex polymers. Applicants' invention contains "acrylic polymer latices", that is aqueous emulsions of acrylate ester polymers, acrylic acid polymers, acrylamide polymers, their copolymers, etc. The examiner is unfamiliar with "alpha-methyl acrylate" polymers. Methacrylate polymers maybe?

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claims 26, 42, 44, 48-54, 56 and 61 cannot be found in the specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Air-dryable polymeric resins do not exist (claims 1, 2, 60 and 65). Neither do acrylic latex polymers (claims 24-26). Applicants' invention contains "acrylic polymer latices", that is aqueous emulsions of acrylate ester polymers, acrylic acid polymers, acrylamide polymers, their copolymers, etc. The examiner is unfamiliar with "alpha-

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methyl acrylate" polymers (claim 25). Methacrylate polymers maybe? The expressions "less than about", "greater than about", "not more than about" and "not less than about" render the claims indefinite. See, *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991). To illustrate the point 239 is about 240. Accordingly, 239.5 is not less than 240, which is absurd.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 1, 6-19, 21, 22, 24, 25, 27, 28, 31-33 and 40-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell et al. 6,103,360, in view of Dassetto 2,895,325, Pfingsten et al. 3,785,568, Stern et al. 5,524,798 or Taylor 6,291,536.

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9. Caldwell et al disclose a coating composition for ceiling boards, containing different particle size fillers, binder and water in claim 1, large fillers in claim 2, medium size fillers in claim 1, limestone and dolomite in claim 9, calcium carbonate, titanium dioxide and clay in claim 10, acrylic binders in claim 11, acrylic latices and thickeners in the Examples, viscosities in column 2, line 41-48 and spray coating in column 3, lines 16-18. Dassetto teaches an apparatus for spray coating ceilings in claims 1-6. Pfingsten et al. recite coating ceilings under pressure in columns 5 and 6 and apparatus for it in claims 1-8. Stern et al. reveal an apparatus for coating a wall or ceiling in claims 1-14. Taylor displays coating ceilings in column 1, lines 40-55, filling gap between panels in column 2, lines 48-50, calcium carbonate in column 4, line 59 acrylic latices in column 3, lines 30-35 and other ingredients in column 5, lines 25-60. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select the coarsest filler in order to lower the viscosity, to choose calcium carbonate from a list of equivalents and to use the apparatuses of the secondary references to coat the surfaces and fill the gaps, since the apparatuses were designed for that very purpose. Grout composition is the intended use and as such it has no patentable significance.

Allowable Subject Matter

10. Claims 2-5, 20, 23, 26, 29, 30 and 34-39 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


11. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
12/22/04